

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant : Cary Lee Bates et al.
Application No. : 10/816,705
Filed : April 2, 2004
For : METHOD OF REMOTELY CONTROLLING SET TOP
BOX VIA TELEPHONE, COMPUTER-READABLE
STORAGE MEDIUM STORING INSTRUCTIONS
FOR SAME AND APPARATUS USING A
TELEPHONE INTERFACE
Examiner : Jun Fei Zhong
Art Unit : 2426

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

BRIEF ON APPEAL

Dear Sir:

In response to the Notification of Non-Compliant Appeal Brief that was mailed March 12, 2009, Applicants submits these two (2) replacement portions of the Appeal Brief in compliance with 37 CFR 41.37. For the reasons more fully set forth below, it is respectfully submitted that the final rejections of claims 1-7 and 9-14 should be reversed.

STATUS OF CLAIMS:

Claims 1-7 and 9-14 have been rejected and are on appeal.
Claim 8 was previously canceled.

ARGUMENT:

REVIEW OF AUGUST

August relates "to a cordless telephone having a portable unit arranged for providing control functions for remotely operated devices." *August*, col. 1, lines 10-12. *August* discusses an arrangement that includes a set-top box 32 attached to a video receiving device 60 and a handset. *August*, col. 10, lines 46-65.

The set-top box receives signals from a video service network 40. *August*, Fig. 5. *August* teaches remotely accessing the set-top box "for altering the configuration of [the set-top box]." In one example, *August* teaches limiting programs that the set-top box can receive by entering codes that enable a first or second set of channels to reach the video receiving device. *August*, Col. 10, lines 45-57.

The cited passages of *August* do not discuss directed a set top box to tune to a television event in accordance with at least one command.

**A PRIMA FACIE CASE OF ANTICIPATION OF CLAIMS 1-5 AND 12-14
HAS NOT BEEN ESTABLISHED AS THE OFFICE ACTIONS FAIL TO ESTABLISH
THAT AUGUST DISCLOSES DIRECTING A SET TOP BOX TO TUNE TO A TELEVISION
EVENT IN ACCORDANCE WITH AT LEAST ONE COMMAND**

Appellants/Applicants respectfully submit that the record fails to establish that each feature of independent claims 1, 12, and 14 is disclosed by August. Accordingly, Appellants/Applicants respectfully submit that the record fails to establish a prima facie case of anticipation.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *MPEP* § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Id.* (citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). Further, "[t]he elements must be arranged as required by the claim..." *Id.* (citing *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)).

Independent claim 1 recites, inter alia,

controlling the set top box via at least one command transmitted by the calling party to the set top box during the telephone call, the controlling including directing the set top box to tune to a television event in accordance with the at least one command.

Independent claims 12 and 14, which each have their own scope, recite similar features.

Appellants/Applicants respectfully submit that the cited passages of *August* fail to disclose at least the above feature. Specifically, Appellants/Applicants respectfully submit that the cited passages of *August* fail to discuss tuning to a television event.

The above expressly-recited claim feature clearly recites directing the set top box to tune to a television event in accordance with the at least one command. The Office Actions contend that *August* discloses this feature. Specifically, at page 2, the Final Office Action contends "a user could access the set top box remotely and enable/disable certain channels deliver[ed] to [the] display device (i.e., ordering the set top box tuning to certain cannels or not tuning to) by enter[ing] the predetermined codes..."

Appellants/Applicants respectfully submit that *August* merely teaches enabling sets of channels to reach the video receiving device. Absent from *August* is any teaching of tuning to a television event via a command. Stated another way, enabling a set of channels to reach a video receiving device is not tuning to a television event.

Further, enabling a set of channels to reach a video receiving device is not tuning to a television event *in accordance with the at least one command*. Accordingly, Appellants/Applicants respectfully submit that *August* cannot properly be relied upon for disclosing the above features.

Favorable review and reversal of the rejection under 35 U.S.C. § 102 are respectfully requested.

A PRIMA FACIE CASE OF OBVIOUSNESS OF CLAIMS 6, 7, 9, 10, AND 11 HAS NOT BEEN ESTABLISHED AS THE OFFICE ACTIONS FAIL TO ESTABLISH THAT THE SECONDARY CITATIONS CURE THE DEFICIENCIES OF THE REJECTION UNDER 35 U.S.C. § 102(B)

Appellants/Applicants respectfully submit that the record fails to establish that the various secondary citations add anything that would remedy the above discussed deficiencies in the primary citation to August. Thus, each of the proposed combinations of citations fails to disclose each and every feature of the claims.

Favorable review and reversal of the rejections under 35 U.S.C. § 103 are respectfully requested.

CONCLUSION

In summary, Appellants/Applicants respectfully submit that claims 1-7 and 9-14 patentably define over the cited art. Reversal of the Examiner's rejections is respectfully requested.

Respectfully Submitted,

Dated: April 13, 2009

A handwritten signature in black ink, appearing to read 'Christopher Paul Mitchell', with a stylized flourish at the end.

Christopher Paul Mitchell
Registration No. 54,946

Dugan & Dugan, PC
Hawthorne, New York
Attorneys for Applicants
(914) 579-2200